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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,914	03/22/2004	Neil Andrew Abeitcrombie Simpson	MRKS/0057.C1	2030

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EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT PAPER NUMBER

3672

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/805,914

Applicant(s)

SIMPSON ET AL.

Examiner

Jennifer H Gay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-48 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-21 and 33-38 is/are allowed.
- 6) ☒ Claim(s) 22-25, 27-34 and 39-48 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/22/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

The Preliminary Amendment filed 20 August 2004 has been entered and considered with the Office Action presented below.

Specification

1. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).
2. The attempt to incorporate subject matter into this application by reference to WO 00/37766 is improper because foreign references may not be incorporated by reference.
3. The disclosure is objected to because of the following informalities: the cross-reference application data should be updated to include the patent number of the parent application.
Appropriate correction is required.

Claim Objections

4. Claim 24 is objected to because of the following informalities: --to-- should be added after "equal" in line 2 of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

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patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 22-25, 31, 32, and 39-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Gano et al. (US 6.568.472).

Regarding claim 22: Gano et al. discloses an apparatus for expanding a tubular.

The apparatus includes the following features:

- An expander 38 that has an outer diameter larger than an inner diameter of the tubular 12 being expanded (Figure 2).
- A seal 28 to create a fluid seal with an unexpanded portion of the tubular. The seal is axially spaced from the expander to provide a fluid volume in an interior section of the unexpanded portion between the expander and the seal.
- A port 30 disposed along the apparatus between the expander and the seal. The port supplies pressurized fluid to the fluid volume.

Regarding claim 23: The seal may include a plurality of sealing members (Figure 1).

Regarding claim 24: The expander has a first portion with a first diameter that is equal to or less than the unexpanded inner diameter of the tubular and a second portion that has a diameter with a second diameter that is greater than the first diameter and a junction therebetween. The seal is axially spaced from the junction (Figure 2).

Regarding claim 25: The expander is a die (3:30-35).

Regarding claim 31: The expander may be fluid pressure actuated (4:33-45).

Regarding claim 32: The tubular is a downhole screen.

Regarding claim 39: Gano et al. discloses a system for expanding a tubular 12.

The system includes the following features:

- An expander 38 that has an outer diameter larger than an inner diameter of the tubular 12 being expanded (Figure 2).
- A seal 28 to create a fluid seal with an unexpanded portion of the tubular ahead of the expander.

- A lubricant 56 supplied to the inner diameter of the tubular and in fluid communication with at least a section of the outer diameter portion of the expander (Figure 2). The examiner notes that element 56 is not described as a lubricant but rather a wash fluid, however, any fluid forced between the seal and the expander would function as a lubricant.

Regarding claims 40, 45: Though not specifically disclosed or shown, the system must inherently include a lubricant supply in order to provide the lubricant downhole. Further, the fluid must be supplied continuously in order to be able to perform its disclosed function of preventing skin (4:5-45).

Regarding claims 41, 46: The lubricant is pressurized.

Regarding claims 42, 47: The lubricant is supplied to an interior of the tubular isolated by the seal and having the expander disposed therein (Figure 2).

Regarding claims 43, 48: The lubricant is pressurized within an interior of the tubular isolated by the seal and having the expander disposed therein.

Regarding claim 44: Gano et al. discloses the method for using the above system. The method involves the following steps:

- Urging the expander against an inside surface of the tubular (Figure 2).
- Sealing an unexpanded portion of the tubular ahead of the expander.
- Supplying the lubricant to the inside surface of the tubular by directing the lubricant against the inside surface of the tubular.
- Expanding the tubular with the expander.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gano et al. (US 6,568,472) in view of Metcalfe et al. (US 6,543,552).

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claims 27, 29, 30: Gano et al. discloses all of the limitations of the above claims except for the expander including a plurality of rotatable expansion members that are either perpendicular to the axis of the tubular or define a cone.

Metcalfe et al. discloses an apparatus similar to that of Gano et al. Metcalfe et al. further teaches the use of expanders 30 and 32 that include a plurality of rotatable expansion members 38 and 42 respectively. The rollers of the upper most expander 30 are situated perpendicular to the axis of the expandable tubular and the rollers of the lower most expander form a cone (Figure 1).

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the expander of Gano et al. to include the rotatable expansion members taught by Metcalfe et al. in order to have expanded individual section of the tubular thus isolating problem formations (2:6-10).

Regarding claim 28: Gano et al. discloses all of the limitations of the above claims except for rotating the expander with a hydraulic drive motor.

Metcalfe et al. further teaches using a downhole hydraulic motor (3:19,20) to rotate the expander.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the apparatus of Gano et al. to include a hydraulic drive motor for rotating the expander as taught by Metcalfe et al. in order to have ensured complete and even expansion of the tubular by rotating the expander and in order to have eliminated the need for surface equipment for imparting the rotation to the expander thus reducing overall costs and saving space of the rig.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 18-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-17 of U.S. Patent No. 6,712,151. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims, though not identical, include essentially the same limitations. The specifics of the similarities are as follows:

- Claim 18 – Claim 14 of U.S. Patent No. 6,712,151 includes the steps of applying fluid pressure to an inside surface of the tubular by directing fluid

against the inside surface of the tubular, applying a mechanical force to the inside surface of the tubular (the step of urging an expander against the inside surface of the tubular is considered the same as applying a mechanical force and the urging being at least partially supplied by an axial load on a running tube is considered to be merely the step of pulling or pushing the expander within the tubular), and expanding the tubular with the combination of the fluid pressure and the mechanical force.

- Claim 19 – Claim 15 of U.S. Patent No. 6,712,151.
- Claim 20 – Claim 16 of U.S. Patent No. 6,712,151.
- Claim 21 – Claim 17 of U.S. Patent No. 6,712,151.

Allowable Subject Matter

11. Claims 18-21 and 33-38 are allowed.
12. Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

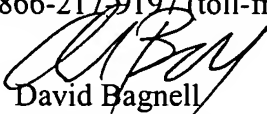
The remaining references made of record disclose various methods and systems for expanding wellbore tubulars.


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David Bagnell
Supervisory Patent Examiner
Art Unit 3672

JHG 
October 26, 2004